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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,347	09/30/1999	KIKUO NAITO	35.C13894	5241
5514	7590	02/04/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			KIM, CHONG R	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/409,347

Applicant(s)

NAITO ET AL.

Examiner

Charles Kim

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15,27 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15,27 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2004 has been entered.

Response to Amendment and Arguments

2. Applicant's amendment filed on July 20, 2004 has been entered and made of record.
3. In view of applicant's amendment, the claim objection is withdrawn.
4. Applicant's arguments with respect to claims 1-3, 6, 8, 10-15, 27, 41 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2623

5. Claims 1, 2, 10, 11, 13-15, 27, 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito, U.S. Patent No. 6,182,218 ("Saito").

Referring to claim 1, Saito discloses an information processing apparatus comprising:

a. discrimination means (watching task) for discriminating a process in which an electronic watermark is to be applied to data that is to be registered (stored), from among a plurality of different processes (authorized or unauthorized editing, authorized or unauthorized storing, authorized or unauthorized copying, authorized or unauthorized transferring) that are executed for the data to be registered (col. 7, lines 40-63, col. 9, lines 3-15, and col. 9, line 66-col. 10, line 7);

b. registration means for setting a plurality of purposes of use (authorized usage and unauthorized usage) for the same data and registering a process (visible or invisible embedding) in which the electronic watermark is to be applied for each purpose of use, so that the electronic watermark is applied to the data to be registered during the process discriminated by the discrimination means based on the registration (col. 9, lines 3-15 and col. 9, line 66-col. 10, line 7). Saito explains that a visible watermark is applied to the data during unauthorized usage, while an invisible watermark is applied to the data during authorized usage).

Referring to claim 2, Saito further discloses that the discrimination means discriminates between a process of registering the data (storing) and a process to be executed after registering the data (editing) [col. 7, lines 40-63, col. 9, lines 3-15, and col. 9, line 66-col. 10, line 7].

Referring to claim 10, Saito further discloses that the discrimination means further discriminates a method of applying an electronic watermark method among plurality of electronic watermarking methods (col. 9, lines 3-15, and col. 9, line 66-col. 10, line 7).

Referring to claim 11, Saito further discloses that the plurality of watermarking methods include at least a first method for employing an electronic watermark as visible information, and a second method for employing an electronic watermark as invisible information (col. 9, lines 3-15, and col. 9, line 66-col. 10, line 7).

Referring to claim 13, Saito further discloses that the discrimination means further discriminates electronic watermark information to be applied to the data (col. 9, lines 20-22).

Referring to claim 14, Saito further discloses a management means for managing the process determined by the discrimination means for each registered data (col. 7, lines 40-63 and figure 2).

Referring to claim 15, Saito discloses an information processing system that executes a plurality of different processes for data to be provided by a user, comprising:

- a. discrimination means (watching task) for discriminating a process in which an electronic watermark is to be applied to data that is to be registered (stored), from among a plurality of different processes (authorized or unauthorized editing, authorized or unauthorized storing, authorized or unauthorized copying, authorized or unauthorized transferring) [col. 7, lines 40-63, col. 9, lines 3-15, and col. 9, line 66-col. 10, line 7];
- b. registration means for setting a plurality of purposes of use (authorized usage and unauthorized usage) for the same data and registering a process (visible or invisible embedding) in which the electronic watermark is to be applied for each purpose of use (col. 9, lines 3-15 and col. 9, line 66-col. 10, line 7. Saito explains that a visible watermark is applied to the data during unauthorized usage, while an invisible watermark is applied to the data during authorized usage);

Art Unit: 2623

c. applying means for applying an electronic watermark to the data provided by a user during the process discriminated by the discrimination means based on the registration by the registration means (col. 8, lines 41-53, col. 9, lines 3-15, and col. 9, line 66-col. 10, line 7).

Referring to claim 27, see the rejection of at least claim 1 above.

Referring to claim 41, see the rejection of at least claim 15 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 6, 8, 9, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Saito, U.S. Patent No. 6,182,218 ("Saito") and Stefik et al., U.S. Patent No. 6,233,684 ("Stefik").

Referring to claim 3, Saito further discloses that the discrimination means discriminates among one of a process of registering (storing) the data and a process of sending (transferring) the registered data (col. 7, lines 40-63, col. 9, lines 3-15), but does not explicitly disclose that the discrimination means discriminates the process of printing the registered data. However, this feature was exceedingly well known in the art. For example, Stefik discloses a discrimination means that discriminates among one of a process of registering the data (col. 12, lines 1-7 and col. 13, lines 26-28), a process of sending the registered data (col. 12, line 54-col. 13, line 2.

Art Unit: 2623

Note that the registered data is sent to the “user” repository), and a process of printing the registered data (col. 13, lines 33-45).

Saito and Stefik are combinable because they are both concerned with networks for controlling the distribution and use of rendered digital works through watermarking. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the discrimination means of Saito so that it discriminates a process of printing the registered data, as taught by Stefik. The suggestion/motivation for doing so would have been to extend the existing capabilities of the system for controlling distribution by providing a measure of protection when a document is printed (Stefik, col. 3, lines 22-25). Therefore, it would have been obvious to combine Saito with Stefik to obtain the invention as specified in claim 3.

Referring to claim 6, Stefik further discloses that the process of printing the registered data is for sending the data to a printer (col. 13, lines 33-45).

Referring to claim 8, Stefik further discloses that the printer deletes data received from the information processing apparatus when print of the data is completed (col. 16, lines 37-39. Note that the print spooler deletes the data after print has been completed).

Referring to claim 9, Saito and Stefik do not explicitly disclose that during printing of the data by the printer, the printer does not halt printing of the data even upon receiving a halting instruction. However, Stefik’s printing process protects the user in the situation where the printing may become inadvertently terminated before the digital work is completely printed (Stefik, col. 13, lines 17-19). Therefore, the Examiner notes that it would have been obvious to continue the printing process even upon receiving a halt instruction. For instance, if the printing process requires a fee (Stefik, col. 13, line 13), one would be motivated to continue printing even

Art Unit: 2623

upon receiving a halt instruction, in order to provide the user with the entire data that they paid for.

Referring to claim 12, Saito does not explicitly disclose that the plurality of electronic watermarking methods includes at least a third method for employing an electronic watermark as removable information, and a fourth method for employing an electronic watermark as unremovable information. However, these features were exceedingly well known in the art. For example, Stefik discloses a plurality of electronic watermarking methods that includes a method for employing an electronic watermark as removable information, and a method for employing an electronic watermark as unremovable information (col. 8, lines 55-56. Note that the visible watermark is removable and the invisible is unremovable).

Saito and Stefik are combinable because they are both concerned with networks for controlling the distribution and use of rendered digital works through watermarking. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the watermarking methods of Saito to include the methods taught by Stefik. The suggestion/motivation for doing so would have been to enhance the flexibility of the watermarking process. Therefore, it would have been obvious to combine Saito with Stefik to obtain the invention as specified in claim 12.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Saito, U.S. Patent No. 6,182,218 ("Saito") and Guedalia et al., U.S. Patent No. 6,148,333 ("Guedalia").

Art Unit: 2623

Referring to claim 4, Saito further discloses an outputting means for outputting the data (col. 9, lines 3-15 and col. 9, line 66-col. 10, line 7), but does not explicitly disclose that the data is outputted after the electronic watermark has been removed from the data. However, this feature was exceedingly well known in the art. For example, Guedalia explains that when a “premium user” requests an image from a server, the server processes the image so that an electronic watermark is not present in the image during output to the user (col. 13, line 57-col. 14, line 26). The Examiner notes that the combination of Saito and Guedalia would result in the “premium user” requesting an image from the server that already includes an electronic watermark (Saito, col. 9, lines 3-15 and col. 9, line 66-col. 10, line 7). Accordingly, the combination of Saito and Guedalia would remove the watermark from the data before being output, in order to ensure that the premium user receives an image in which an electronic watermark is not present (Guedalia, col. 13, line 57-col. 14, line 26).

Saito and Guedalia are combinable because they are both concerned with networks for controlling the distribution and use of rendered digital works through watermarking. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the system of Saito so that it outputs the data after the electronic watermark has been removed from the data, as taught by Guedalia. The suggestion/motivation for doing so would have been provide the premium user with an image that has not been deteriorated by a watermark. Therefore, it would have been obvious to combine Saito with Guedalia to obtain the invention as specified in claim 4.

Art Unit: 2623

8. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Saito, U.S. Patent No. 6,182,218 ("Saito"), Stefik et al., U.S. Patent No. 6,233,684 ("Stefik"), and Guedalia et al., U.S. Patent No. 6,148,333 ("Guedalia").

Referring to claim 5, Saito further discloses a display means (4) for displaying data which the electronic watermark is applied to (figures 2-4), but does not explicitly disclose a print means for printing the data. However, this feature was exceedingly well known in the art. For example, Stefik discloses a print means for printing watermarked/un-watermarked data (col. 15, lines 6-25).

Saito and Stefik are combinable because they are both concerned with networks for controlling the distribution and use of rendered digital works through watermarking. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the system of Saito to include the printing means of Stefik. The suggestion/motivation for doing so would have been to extend the existing capabilities of the system for controlling distribution by providing a measure of protection when a document is printed (Stefik, col. 3, lines 22-25). Therefore, it would have been obvious to combine Saito with Stefik.

Saito and Stefik do not explicitly disclose that the printing means prints out the data after the electronic watermark has been removed from the data. However, this feature was exceedingly well known in the art. For example, Guedalia explains that when a "premium user" requests an image from a server, the server processes the image so that an electronic watermark is not present in the image during output to the user (col. 13, line 57-col. 14, line 26). The Examiner notes that the combination of Saito, Stefik, and Guedalia would result in the "premium user" requesting an image from the server that already includes an electronic watermark (Saito,

Art Unit: 2623

col. 9, lines 3-15 and col. 9, line 66-col. 10, line 7). Accordingly, the combination of Saito, Stefik, and Guedalia would remove the watermark from the data before being printed, in order to ensure that the premium user receives an image in which an electronic watermark is not present (Guedalia, col. 13, line 57-col. 14, line 26).

Saito, Stefik, and Guedalia are combinable because they are all concerned with networks for controlling the distribution and use of rendered digital works through watermarking. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the system of Saito and Stefik so that it prints the data after the electronic watermark has been removed from the data, as taught by Guedalia. The suggestion/motivation for doing so would have been provide the premium user with an image that has not been deteriorated by a watermark. Therefore, it would have been obvious to combine Saito and Stefik with Guedalia to obtain the invention as specified in claim 5.

Referring to claim 7, see the rejection of at least claim 5 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ck

February 2, 2005


Jon Chang
Primary Examiner